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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/688,441	10/17/2003	Samuel B. Osae	P-1086 C	1558

7590 09/28/2006

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EXAMINER

NUTTER, NATHAN M

ART UNIT	PAPER NUMBER
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1711

DATE MAILED: 09/28/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/688,441

Applicant(s)

OSAE ET AL.

Examiner

Nathan M. Nutter

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 August 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 and 10-33 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8, 10-16 and 17-33 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

In response to the amendment of 11 August 2006, the following is being placed into effect.

The rejection of claims 27 and 29 under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement, is hereby expressly withdrawn.

The rejection of claims 1-8 and 10-29 under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention, is hereby expressly withdrawn.

The rejection of claims 1-5, 7, 8, 10-13, 15-20, 23 and 26-29 under 35 U.S.C. 102(b) as being anticipated by Gosiewski et al (U.S. Patent 5,206,288), is hereby expressly withdrawn.

The rejection of claims 1-5, 7, 8, 10-13, 15, 16, 18-20, 23 and 26-29 under 35 U.S.C. 102(b) as being anticipated by Gosiewski et al (U.S. Patent 5,945,461), is hereby expressly withdrawn.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-8, 10-16 and 18-33 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claims contain subject

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matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The recitation in claims 1, 2, 3 and 29 of "(2) flexibilized, low-to medium (sic) reactivity" has no antecedent bases in the Specification, as filed. Further, the recitation in each of these claims regarding "(b) a mixture of (a) with a monomer or mixture of monomers," does not have antecedent bases in the Specification.

Claims 1-8, 10-16 and 18-33 are rejected under 35 U.S.C. 112, first paragraph, as based on a disclosure which is not enabling. The identities of the recited "monomer or mixture of monomers" which are critical or essential to the practice of the invention, but not included in the claims is not enabled by the disclosure. See *In re Mayhew*, 527 F.2d 1229, 188 USPQ 356 (CCPA 1976). The Specification fails to teach or disclose what monomers may be employed.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-3, 5, 7, 10, 13, 18-21, 23 and 26-29 are rejected under 35 U.S.C. 102(b) as being anticipated by Zalucha et al (US Patent 4,293,665).

The reference to Zalucha et al (US Patent 4,293,665) teaches the manufacture of an adhesive composition having a "thermoplastic or partially thermoplastic polymer or elastomer....an unsaturated polyester resin or vinyl ester resin, and....an alkyl acrylate or methacrylate monomer," as recited and claimed herein. Note the Abstract and column 5 (line 60) to column 6 (line 28) for the broad concept including the compositional limitations as recited herein for claims 1-3, 13 and 7 for the methacrylate ester monomers employed, as recited in claim 10, column 6 (line 5) for the use of an organic acid, including methacrylic acid, as recited in claims 18 and 19, and column 6 (lines 6-13) for the use of blends as recited in claim 5. Note column 7 (lines 18-23) for the use of maleic acid, as recited in claim 20. The polyester may be produced from "higher polybasic acids, such as phthalic acid," which includes "orthophthalic , isophthalic and terephthalic" acid. Note column 7 (lines 53 et seq.) for the use of a phosphate ester, as recited in claim 21.

Response to Arguments

Applicant's arguments filed 26 January 2006 have been fully considered but they are not persuasive.

With regard to the rejection of the claims over Zalucha et al (US 4,293,665), it is irrelevant if a constituent in the patent is disclosed as being optional. The disclosure positively shows the inclusion, even if optional, of the polyester component. It is submitted that the inclusion of the alkyl acrylate monomers, as shown in the examples, would provide a degree of cross-linking of the elastomer component. Further, it is pointed out that the referenc does teach the inclusion of phthalic acid as a suitable

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polybasic acid in producing the polyesters. Note column 7 (lines 35-38). Phthalic acid occurs in three isomers, iso-, tere- and ortho-, as claimed herein. The phthalic acid disclosed would clearly embrace the recitations of the instant claims.

All claims are drawn to the same invention claimed in the application prior to the entry of the submission under 37 CFR 1.114 and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the application prior to entry under 37 CFR 1.114. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action after the filing of a request for continued examination and the submission under 37 CFR 1.114. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

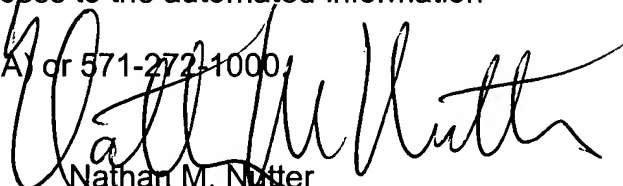
A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nathan M. Nutter whose telephone number is 571-272-1076. The examiner can normally be reached on 9:30 a.m.-6:00 p.m..

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James J. Seidleck can be reached on 571-272-1078. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Nathan M. Nutter
Primary Examiner
Art Unit 1711

nmn

26 September 2006